

REMARKS

In the Final Office Action¹, the Examiner took the following actions:

- I. objected to claim 72;
- II. rejected claims 1, 2, 5-13, 16-19, 24, 28, 29, 32-40, 43-46, 51-53, 56-64, 69-72, 75, 76, 78, and 79 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,304,857 to Heindel et al. ("*Heindel*") in view of U.S. Patent App. Pub. No. 2004/0205635 to Pratte ("*Pratte*");
- III. rejected claims 14 and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte*, and further in view of U.S. Patent App. Pub. No. 2003/0208720 to Anderson et al. ("*Anderson '720*");
- IV. rejected claims 15 and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte*, and further in view of U.S. Patent No. 7,379,978 to Anderson et al. ("*Anderson '978*");
- V. rejected claims 20, 47, and 66 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte*, and further in view of U.S. Patent App. Pub. No. 2002/0038305 to Bahl et al. ("*Bahl*");
- VI. rejected claims 21, 22, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte* and *Bahl*, and further in view of U.S. Patent App. Pub. No. 5,978,836 to Ouchi et al. ("*Ouchi*");
- VII. rejected claims 23 and 50 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte* and *Bahl*, and further in view of Official Notice;
- VIII. rejected claims 54, 55, 73, 74, and 77 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte*, and further in view of *Ouchi*;
- IX. rejected claims 65 and 68 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte*, and further in view of U.S. Patent App. Pub. No. 2003/0028495 to Pallante et al. ("*Pallante*"); and
- X. rejected claim 67 under 35 U.S.C. § 103(a) as being unpatentable over *Heindel* in view of *Pratte*, and further in view of U.S. Patent App. Pub. No. 2003/0145047 to Upton et al. ("*Upton*").

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

By this Amendment, Applicants propose to amend claims 1, 2, 5, 8, 9, 11-20, 28, 29, 32-47, 53-58, 61, 63-65, 68, 70-73, and 75-77. Claims 1, 2, 5-24, 28, 29, 32-51, and 53-79 remain pending in this application.

In view of the foregoing amendments and the following remarks, Applicant respectfully traverses the rejections and requests reconsideration and allowance of the pending claims.

I. Objection to Claim 72

The Office Action objected to claim 72 for alleged informalities. See Final Office Action, p. 5. In response, Applicants propose to amend claim 72 to recite “an electronic” instead of “a electronic,” according to the Examiner’s suggestion. Therefore, Applicants request that the Examiner withdraw the objection.

II. Rejections of Claims

Applicants respectfully traverse the rejections of claims 1, 2, 5-13, 16-19, 24, 28, 29, 32-40, 43-46, 51-53, 56-64, 69-72, 75, 76, 78, and 79 under 35 U.S.C. § 103(a) as unpatentable over *Heindel* in view of *Pratte*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, as proposed to be amended, recites a method for processing an electronic document, including:

receiving, from the receiving party [of the document], second information including a first data field selected from the second plurality of data fields [supplied by an issuing party of the document]; [and]

receiving, from the receiving party, third information including a second data field.

The Office Action asserted that *Heindel* teaches these elements. See Final Office Action, p. 7. However, this assertion is not correct. *Heindel* does not teach or suggest these elements of claim 1.

Particularly, the Office Action cited column 2, lines 55-67 of *Heindel* as support for its assertion. See Final Office Action, p. 7. However, the cited portion of *Heindel* merely teaches that the biller integration system assists the biller to create statement templates. Neither is the biller integration system of *Heindel* an issuing party of the bill, nor is the biller a receiving party of the bill.

In fact, *Heindel* discloses that “[t]he billing statement 50 has a main body 58 that contains numerous data fields for the billing particulars. On the summary page of the energy bill, the billing data fields in 60 body 58 include an amount due, an amount previously paid, and a payment due date.” *Heindel*, col. 6, ll. 57-61. More specifically,

Heindel discloses using “[a] statement designer 62 [to] enable[] the biller to embed and organize data fields.” *Heindel*, col. 7, ll. 30-31. That is, *Heindel* discloses allowing a biller, who is actually the issuing party of billings, to use data fields to customize the billings before they are sent to the customers, who are the receiving parties of the billings.

However, *Heindel* is completely silent with respect to allowing the customers (the receiving parties of the billings) to customize the billings by selecting data fields proposed by the biller (the issuing party of the billings). As such, *Heindel* fails to disclose or suggest “receiving, from the receiving party [of the document], second information including a first data field selected from the second plurality of data fields [supplied by an issuing party of the document],” as recited in claim 1 (emphases added).

Additionally, *Heindel* does not disclose “receiving, from the receiving party, third information including a second data field,” as further recited in claim 1. As stated above, *Heindel* discloses allowing a biller to use data fields to customize the billings before they are sent to the customers. *Heindel* does not disclose allowing customers to customize billings with customer-provided data fields. Therefore, *Heindel* fails to disclose or suggest “receiving, from the receiving party, third information including a second data field,” as recited in claim 1.

Pratte fails to cure the deficiencies of *Heindel*. The Office Action asserted that *Pratte* teaches “a data handler system.” Final Office Action, p. 8. Without acquiescing to this assertion, Applicants respectfully submit that *Pratte* also fail to teach or suggest the above-noted elements recited in claim 1, and thus does not compensate for the deficiencies of *Heindel*.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims, and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and claim 1 is allowable.

Independent claims 28, 53, and 72, although of a different scope from independent claim 1, include recitations similar to those discussed above in connection with independent claim 1. Accordingly, for at least reasons similar to those discussed above, claims 28, 53, and 72 are allowable.

Claims 2, 5-13, 16-19, 24, 29, 32-40, 43-46, 51, 52, 56-64, 69-71, 75, 76, 78, and 79 are also allowable at least by virtue of their dependence from one of claims 1, 28, 53, or 72.

Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 2, 5-13, 16-19, 24, 28, 29, 32-40, 43-46, 51-53, 56-64, 69-72, 75, 76, 78, and 79 under 35 U.S.C. § 103(a).

Moreover, Applicants respectfully traverse the rejections of claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

Claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77 depend from independent claims 1, 28, 53, and 72, and include all the elements thereof. As discussed above, *Heindel* and *Pratte*, whether taken alone or in combination, do not disclose or suggest, at least, "receiving, from the receiving party [of the document],

fields [supplied by an issuing party of the document]" and "receiving, from the receiving party, third information including a second data field," recited in claim 1 and similar recitations in claims 28, 53, and 72. *Anderson '720*, *Anderson '978*, *Bahl*, *Ouchi*, *Official Notice*, *Pallante*, and *Upton*, either individually or in combination, do not compensate for the deficiencies of *Heindel* and *Pratte*. That is, *Heindel*, *Pratte*, *Anderson '720*, *Anderson '978*, *Bahl*, *Ouchi*, *Official Notice* (even if properly taken, which Applicant does not concede), *Pallante*, and *Upton* also do not disclose or suggest the above-noted elements as recited in claim 1 and similar recitations of claims 28, 53, and 72, and included in claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims, and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 14, 15, 20-23, 41, 42, 47-49, 50, 54, 55, 64, 66, 68, 73, 74, and 77, and the Examiner should withdraw the rejections of the claims under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicants submit that the proposed amendments of claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed or inherent in the claims

as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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